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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/986,696	12/08/97	JEJELOWO	M 97U001

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IM62/1024

EXAMINER

RABAGO, R

ART UNIT

PAPER NUMBER

1713

19

DATE MAILED: 10/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/986,696

Applicant(s)
Jejelowo et al.

Examiner
R. Rabago

Group Art Unit
1713



☒ Responsive to communication(s) filed on Aug 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-14, 16-23, 25-32, and 51-57 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-14, 16-23, 25-32, and 51-57 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. An appeal brief filed 8/9/2000 is acknowledged. The finality of the previous Office action is withdrawn in view of the new ground of rejection over a newly located reference as set forth in items 9 and 11 below.
2. Rejections under 35 USC 112 are withdrawn in view of the amendment filed 5/26/2000, which was entered upon the filing of an appeal brief.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 10-12, 14, 16, 19, 28-30, 51, 52, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington (US 5,621,054) for the reasons set forth in item 5 of the Office action mailed 3/20/2000.

Applicants' arguments filed 8/9/2000 have been fully considered but they are not persuasive. Applicants imply that one of ordinary skill would be led away from the use of hafnocenes on the grounds of lower catalyst activity and molecular weight. This argument entirely ignores the primary goal of the patented process, i.e., the making of cyclic olefin

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copolymers of high crystalline melting point (see Summary of the Invention, col. 1, line 65-67). Only reference examples 1-3 (all of which use hafnium) have measurable high melting points, and therefore, based upon the asserted goals of the invention, one of ordinary skill would look to hafnocene catalysts as being highly preferred because they achieve the object of the invention. It is further noted that hafnocenes alone are specified in claim 2.

Applicants' further allegation that Harrington "does not single out the t-butyl substituent" (pg. 5 of brief) is explicitly false. Note col. 3, lines 63-67 and the diagram at col. 4, as well as Examples 1-3 and claim 9.

Finally, applicants' statement that "no where within the four corners of Harrington is there any statement wherein the "patentee clearly states that common alkyl groups are satisfactory for use at the required substitution site"" (pg. 5 of brief) is not consistent with the knowledge of an ordinary chemist. For guidance in what one of ordinary skill in the art would immediately envisage as within the meaning of "alkyl substitution of C₁ or higher carbon number" applicants are directed to the definition of "alkyl" at page 34 of Hawley's Condensed Chemical Dictionary. Harrington specifically states that an alkyl group should be used at the 3-cyclopentadienyl position, and has highlighted t-butyl.

Regarding applicants' comparative examples, it is acknowledged that unexpectedly greater activity has been shown with respect to ethylene/1-butene copolymerizations using the conditions exemplified. However, given the unpredictability of the catalytic/polymerization art, there is no reason to believe that this effect would be observed in all polymerizations within the claimed

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scope. More particularly, applicants have provided no evidence that the use of a metallocene within the claimed scope in the exemplified method of the reference would yield any unexpected properties.

5. Claims 10-14, 16, 17, 20, 27-32, 51-54, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. (US 5,387,660) for the reasons set forth in item 6 of the Office action mailed 3/20/2000.

Applicants' arguments filed 8/9/2000 have been fully considered but they are not persuasive. Applicants' arguments are similar to those over Harrington, i.e., that since the claimed alkyl groups are not specifically named, the skilled polymerization chemist would not be led to the specified hafnocenes. However, Doyle has stated that the pendant alkyl groups are "particularly alkyl groups having 1 to 5 carbon atoms", and has exemplified t-butyl hafnocenes in the cited examples. For guidance in what one of ordinary skill in the art would immediately envisage as within the meaning of "alkyl groups having 1 to 5 carbon atoms" applicants are directed to the definition of "alkyl" at page 34 of Hawley's Condensed Chemical Dictionary.

Regarding applicants' comparative examples, it is acknowledged that unexpectedly greater activity has been shown with respect to ethylene/1-butene polymerizations using the conditions exemplified. However, given the unpredictability of the catalytic/polymerization art, there is no reason to believe that this effect would be observed in all polymerizations within the claimed scope. More particularly, applicants have provided no evidence that the use of a metallocene

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within the claimed scope in the exemplified method of the reference would yield any unexpected properties.

6. Claims 10-14, 16-23, 25, 26, 28-31, and 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jejelowo et al. 5,281,679 for the reasons set forth in item 13 of the Office action mailed 10/12/99.

Applicants' arguments have been fully considered but they are not persuasive. Applicants' argument is based on the contention that unexpected results have been shown. Regarding applicants' comparative examples, it is acknowledged that unexpectedly greater activity has been shown with respect to ethylene/1-butene polymerizations using the conditions exemplified. However, the disclosure and claims of the reference are directed to both homopolymerization and copolymerization. Applicants have provided no evidence or other reasonable basis to believe that the improved activity shown for ethylene/butene copolymerization would be extended to homopolymerizations of, for example, ethylene or propylene. Given the unpredictability of the catalytic/polymerization art, there is no reason to believe that this effect would be observed in all polymerizations within the claimed scope.

7. Claims 18, 19, 21-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. (US 5,387,660), optionally in view of Tsutsui (US 5,714,426) for the reasons set forth in item 8 of the Office action mailed 3/20/2000.

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Applicants' traversal is based upon traversal of Doyle (see item 5 above). Accordingly, no further comment is necessary.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 10 and 14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5 and 7 of copending Application No. 09/207,213. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 11-13, 16-23, 25-32 and 51-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 7-14 of copending Application No. 09/207,213. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the copending claims are of slightly different wording and scope, a substantially identical process of olefin polymerization using a substituted hafnocene catalyst has been claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rabago whose telephone number is (703) 308-4347. The examiner can normally be reached from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are: (703) 305-5408 (official), (703) 305-3599 (official after final) and (703) 306-3429 (unofficial).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

RRabago *RR*
October 23, 2000

David W. Wu
DAVID W. WU
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